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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/909,250
Filing Date: July 19, 2001
Appellant(s): MANCISIDOR ET AL.

William S. Morriss
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 20, 2008 appealing from the Office action mailed May 14, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,963,939	McCann et al.	10-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1 – 8, 41 – 46, 51, and 66 – 82** are rejected under 35 U.S.C. 102(e) as being anticipated by **McCann et al. (US Patent 5,963,939)**.

3. In regards to **claim 1**, **McCann** discloses a method for recommending a product using a computer implemented expert system, the method comprising:

utilizing the expert system to determine problem domain information via interaction between a live human agent and a customer **(Col. 1 Lines 26 – 29; Col. 2 Lines 36 – 52)**;

utilizing the expert system to determine need information of the customer via interaction between the live human agent and the customer, wherein the need information relates to telecommunication needs of the customer **(Col. 1 Lines 26 – 29; Col. 2 Lines 36 – 38, 55 – 59; Col. 3 Lines 1 – 4)**;

inputting the customer need information into the expert system, wherein the act of inputting the customer need information into the expert system is performed by the live human agent **(Col. 3 Lines 1 – 4, 30 – 34)**;

transforming the customer need information into a trait, the trait being characteristic of a telecommunications product of relevance to the customer, the telecommunications product of relevance being selected from a plurality of available telecommunications products **(Col. 3 Lines 39 – 46)**;

calculating a rating of at least three telecommunications product within the plurality of available telecommunications products, wherein the act of calculating the rating is performed by the expert system **(Col. 4 Lines 24 – 30; see also at least Fig. 51 wherein multiple product, each having a particular rating, are presented to the user)**; and

presenting an output comprising a recommended solution, a compatible solution, and a not recommended solution, wherein each of said recommended solution, said compatible solution and said not recommended solution are alternative solutions selected from the plurality of available telecommunications products by the expert system, and wherein said output is generated by said expert system **(Col. 3 Lines 18 – 22; Col. 4 Lines 24 – 33)**.

For the purposes of this examination, the Examiner considers recommended solution, compatible solution, and not recommended solution as non-functional descriptive limitations. As far as the Examiner is concerned nothing has been done with the solutions. That is to say, the solutions are only being presented to the user and are

not further used in the claim and, as a result, are descriptive in nature. The Examiner asserts that **McCann** presents the user with product**s** and service**s**, networking configuration, and other solution attributes that perhaps the VAR or end user might not have considered, i.e. **McCann** provides several other solutions to the user **(Col. 3 Lines 18 – 22)**.

Furthermore, **McCann** discloses that although 1 recommended solution is displayed to the user the expert system also presents the user with other compatible solutions. That is to say, the user is presented with the incremental editor which allows a user to substitute another product or slightly higher or lower rank for a product **already defined as part of the solution (Col. 4 Lines 31 – 33)**. Looking at Fig. 51, for example, the user is able to click on the "+" and "-" buttons in order to navigate through the compatible products/solutions. Consequently, the user is, indeed, presented with compatible solutions.

Regarding the not recommended solution, the Examiner asserts that **McCann** accomplishes this in two ways. The first being that any solution that was not initially presented to the user in **Fig. 51** is a "not recommended solution." That is to say, the compatible solutions are also considered as not recommended solutions in that a compatible solution is not the recommended solution that the system initially provided to the user. Second, the user also has access to all available products that the system may provide. As a result, any solution that has not been presented to the user through **at least** the incremental editor is considered a "not recommended solution" and although the not recommended solution has not been displayed the user still can be

presented with the not recommended solutions by just navigating through the expert system.

Finally, the user is also presented with the option to print out whatever is displayed on the screen **(Fig. 51)** and, consequently, all solutions can be printed out in a paper format. For example, a user who prefers to have everything in writing has the option to print out all the solutions that are being presented by the expert system through the use of the incremental editor and can have all the paper copies of each of the solutions presented to the user at the same time. As a result, **McCann** has presented another alternative to how the solutions are to be presented.

4. In regards to **claim 2**, **McCann** discloses wherein utilizing the expert system to determine the need information of the customer comprises asking questions provided by the expert system and inputting the customer need information into the expert system via a graphical user interface serviced by an agent computer **(Col. 3 Lines 37 – 46)**.

5. In regards to **claim 3**, **McCann** discloses summarizing the ratings of the plurality of telecommunications products **(Col. 11 – 12 Lines 66 – 6; Col. 12 Lines 25 – 38)**; and

providing explanation of the ratings of the plurality of available telecommunications products **(Col. 11 – 12 Lines 66 – 6)**.

6. In regards to **claim 4**, **McCann** discloses wherein the summary of the ratings of the plurality of available telecommunications products comprises at least one of the

recommended solution, the compatible solution, and the not recommended solution **(Col. 3 Lines 18 – 22)**.

7. In regards to **claim 5**, **McCann** discloses wherein the plurality of available telecommunications products comprises a service **(Col. 3 Lines 30 – 34)**.

8. In regards to **claim 6**, **McCann** discloses further comprising communicating the rating from the live human agent to the customer and wherein the calculating the rating of the at least three telecommunications product within the plurality of available telecommunications products is performed in real time **(Col. 1 Lines 26 – 29; Col. 3 Lines 34 – 39)**.

9. In regards to **claim 7**, **McCann** discloses wherein the expert system employs a fuzzy value in calculating the rating of the at least three telecommunications product **(Col. 2 Lines 48 – 52)**.

10. In regards to **claim 8**, **McCann** discloses wherein the expert system employs a crisp value in calculating the rating of the at least three telecommunications product **(Col. 4 Lines 25 – 30)**.

11. In regards to **claim 41**, **McCann** discloses an expert system that is operable for recommending a product, the expert system comprising:

a computer network **(Figure 1)**;

a live human agent interface, communicatively coupled to the computer network, comprising a graphical user interface **(Figure 45)**;

a product database communicatively coupled to the computer network that contains a plurality of available telecommunications products, the product database

being communicatively coupled to a plurality of providers of the plurality of available telecommunications products thereby allowing updating of the product database in real time **(Col. 2 Lines 64 – 67; Col. 20 Lines 23 – 25)**; and

an expert system, communicatively coupled to the computer network, that is operable to rate at least two available telecommunications products within the plurality of available telecommunications products using dynamic calculation and based on a customer need **(Col. 3 Lines 10 – 22; Col. 15 lines 42 – 45)**;

wherein the expert system comprises computer executable instructions which allow a live human agent to perform selection of an available telecommunications product from the product database based on the rating of the at least two available telecommunications product during an interaction with a customer **(Col. 3 Lines 10 – 22; Col. 15 Lines 42 – 45)**;

wherein the expert system generates output comprising a recommended telecommunications solution and a compatible telecommunications solution and presents the output to the live human agent via the graphical user interface, each of the recommended telecommunications solution and a compatible telecommunications solution being an alternative solution selected from the plurality of available telecommunications products within the product database, the recommended telecommunications solution **(Col. 4 Lines 24 – 30; Figure 50; Figure 51)**; and

wherein the recommended telecommunications solution and the compatible telecommunications solution are communicated to the customer in real time after the expert system generates the output **(Col. 3 Lines 30 – 34)**.

12. In regards to **claim 42**, **McCann** discloses wherein at least one of the recommended solution and the compatible solution comprises at least one of a data network solution and an Internet access solution **(Figure 50)**.

13. In regards to **claim 43**, **McCann** discloses wherein the output further comprises an explanation for why the recommended solution was selected by the expert system **(Col. 3 Lines 10 – 22)**.

14. In regards to **claim 44**, **McCann** discloses wherein the expert system employs at least one of a dedicated Internet access guidance engine and a data network guidance engine to rate the at least two available products within the plurality of available products **(Col. 2 Lines 59 – 63; Col. 3 Lines 10 – 22; Col. 4 Lines 20 – 30; Col. 15 Lines 42 – 45; Col. 20 Lines 23 – 25)**.

15. In regards to **claim 45**, **McCann** discloses wherein the graphical user interface is operable to present information concerning at least one of the available products within the plurality of available products to the live human agent **(Figure 50)**.

16. In regards to **claim 46**, **McCann** discloses a plurality of software instructions stored on a media that, upon execution by a processing circuitry, are operable to recommend a product by using an expert system, comprising:

a set of instruction executed by the processing circuitry that determines problem domain information during an interaction between a live human agent and a customer, wherein the problem domain relates to a telecommunications network configuration **(Col. 1 Lines 26 – 29; Col. 2 Lines 36 – 38)**;

a set of instruction executed by the processing circuitry that determines need information of the customer during the interaction between the live human agent and the customer, wherein the need information relates to a telecommunications network configuration **(Col. 1 Lines 26 – 29;; Col. 2 Lines 36 – 38, 55 – 59; Col. 3 Lines 1 – 4)**;

a set of instruction executed by the processing circuitry that inputs the customer need information into the expert system **(Col. 3 Lines 1 – 4)**;

a set of instruction executed by the processing circuitry that transforms the customer need information into a trait, the trait being characteristic of a product of relevance to the customer as determined using expert system processing that is performed by the expert system, the product of relevance being selected from a plurality of available products **(Col. 3 Lines 39 – 46)**;

a set of instruction executed by the processing circuitry that rates a product within the plurality of available products using the expert system, wherein the product comprises a telecommunications network configuration **(Col. 4 Lines 24 – 30)**; and

a set of instructions executed by the processing circuitry that presents an output to the live human agent, said output comprising a recommended solution, and a not-recommended solution, wherein the recommended solution and the not-recommended solution comprise alternative products selected from the plurality of available products **(Col. 3 Lines 18 – 22; Col. 4 Lines 24 – 33)**.

For the purposes of this examination, the Examiner considers recommended solution and not recommended solution as non-functional descriptive limitations. As far as the Examiner is concerned nothing has been done with the solutions. That is to say,

the solutions are only being presented to the user and are not further used in the claim and, as a result, are descriptive in nature. The Examiner asserts that **McCann** presents the user with product**s** and service**s**, networking configuration, and other solution attributes that perhaps the VAR or end user might not have considered, i.e. **McCann** provides several other solutions to the user **(Col. 3 Lines 18 – 22)**.

Regarding the not recommended solution, the Examiner asserts that **McCann** accomplishes this in two ways. The first being that any solution that was not initially presented to the user in **Fig. 51** is a "not recommended solution." That is to say, the compatible solutions **(as discussed above in claim 1)** are also considered as not recommended solutions in that a compatible solution is not the recommended solution that the system initially provided to the user. Second, the user also has access to all available products that the system may provide. As a result, any solution that has not been presented to the user through **at least** the incremental editor is considered a "not recommended solution" and although the not recommended solution has not been displayed the user still can be presented with the not recommended solutions by just navigating through the expert system.

Finally, the user is also presented with the option to print out whatever is displayed on the screen **(Fig. 51)** and, consequently, all solutions can be printed out in a paper format. For example, a user who prefers to have everything in writing has the option to print out all the solutions that are being presented by the expert system through the use of the incremental editor and can have all the paper copies of each of

the solutions presented to the user at the same time. As a result, **McCann** has presented another alternative to how the solutions are to be presented.

17. In regards to **claim 51, McCann** discloses a plurality of software instructions stored on a media that, upon execution by a processing circuitry, are operable to recommend a telecommunications network configuration, comprising;

a set of instruction executed by the processing circuitry that performs expert system processing to rate at least two available products within a plurality of available products using dynamic calculation and based on a customer need, wherein the products comprise a telecommunications network configuration **(Col. 3 Lines 1 – 22; Col. 15 Lines 42 – 45)**;

a set of instruction executed by the processing circuitry that enable a live human agent to respond to a communication of a customer need by accessing the functionality of the expert system processing via the graphical user interface to perform selection of an available product form the product database based on the rating of the at least two available products in real time during an interaction with a customer **(Col. 3 Lines 1 – 22, 30 – 46; Col. 15 Lines 42 – 45)**;

a set of instruction executed by the processing circuitry that generates output comprising a recommended solution and a compatible solution and presents the output to the live human agent via the graphical user interface, each of the recommended solution and a compatible solution being an alternative solution selected from the plurality of available products within the product database, the recommended solution

having a rating that is higher than the rating of the compatible solution **(Col. 3 Lines 18 – 22, 30 – 46; Col. 4 Lines 24 – 30)**; and

a set of instruction executed by the processing circuitry that prompts the live agent with the recommended solution comprising a network configuration and the compatible solution to be communicated to the customer in real time **(Col. 3 Lines 30 – 46)**.

18. In regards to **claim 66**, **McCann** discloses wherein the plurality of available telecommunications products comprises a plurality of telecommunications network configurations **(Col. 3 Lines 1 – 22)**.

19. In regards to **claim 67**, **McCann** discloses wherein the rated telecommunications product comprises a telecommunications network product comprises a telecommunications network configuration **(Col. 3 Lines 1 – 22; Figure 50)**.

20. In regards to **claim 68**, **McCann** discloses a method of providing a network configuration solution to a customer, the method comprising:

utilizing an expert system to obtain information from a customer regarding product needs of the customer via interaction between a live human agent and the customer **(Col. 1 Lines 26 – 29; Col. 2 Lines 36 – 38, 55 – 59; Col. 3 Lines 1 – 4)**;

presenting an interface allowing the live human agent to enter the information into a computer system, wherein the computer system comprises the expert system **(Col. 3 Lines 1 – 4)**;

processing the information, wherein the act of processing is performed by the expert system within the computer system **(Col. 3 Lines 39 – 46)**;

producing at least three product solutions, wherein the at least three product solutions are produced by the expert system within the computer system, wherein the act of producing at least three product solutions is performed in accordance with the entered and processed information, wherein said at least three product solutions comprise a recommended solution, a compatible solution, and a not recommended solution, and wherein said recommended solution, said compatible solution, and said not recommended solution comprise alternative solutions **(Col. 3 Lines 1 – 22)**;

presenting the at least three product solution to the human agent, wherein the act of presenting that at least three product solution to the live human agent is performed by the computer system **(Figure 50)**; and

presenting at least a portion of the at least three product solution produced by the expert system to the customer, wherein the act of presenting at least a portion of the at least one product solution to the customer is performed by the live human agent **(Col. 3 Lines 30 – 34)**.

For the purposes of this examination, the Examiner considers recommended solution, compatible solution, and not recommended solution as non-functional descriptive limitations. As far as the Examiner is concerned nothing has been done with the solutions. That is to say, the solutions are only being presented to the user and are not further used in the claim and, as a result, are descriptive in nature. The Examiner asserts that **McCann** presents the user with product**s** and service**s**, networking configuration, and other solution attributes that perhaps the VAR or end user might not

have considered, i.e. **McCann** provides several other solutions to the user **(Col. 3 Lines 18 – 22)**.

Furthermore, **McCann** discloses that although 1 recommended solution is displayed to the user the expert system also presents the user with other compatible solutions. That is to say, the user is presented with the incremental editor which allows a user to substitute another product or slightly higher or lower rank for a product **already defined as part of the solution (Col. 4 Lines 31 – 33)**. Looking at Fig. 51, for example, the user is able to click on the "+" and "-" buttons in order to navigate through the compatible products/solutions. Consequently, the user is, indeed, presented with compatible solutions.

Regarding the not recommended solution, the Examiner asserts that **McCann** accomplishes this in two ways. The first being that any solution that was not initially presented to the user in **Fig. 51** is a "not recommended solution." That is to say, the compatible solutions are also considered as not recommended solutions in that a compatible solution is not the recommended solution that the system initially provided to the user. Second, the user also has access to all available products that the system may provide. As a result, any solution that has not been presented to the user through **at least** the incremental editor is considered a "not recommended solution" and although the not recommended solution has not been displayed the user still can be presented with the not recommended solutions by just navigating through the expert system.

Finally, the user is also presented with the option to print out whatever is displayed on the screen **(Fig. 51)** and, consequently, all solutions can be printed out in a paper format. For example, a user who prefers to have everything in writing has the option to print out all the solutions that are being presented by the expert system through the use of the incremental editor and can have all the paper copies of each of the solutions presented to the user at the same time. As a result, **McCann** has presented another alternative to how the solutions are to be presented.

21. In regards to **claim 69**, **McCann** discloses wherein the act of processing comprises using fuzzy logic to product at least on product solution **(Col. 2 Lines 48 – 52)**.

22. In regards to **claim 70**, **McCann** discloses wherein the act of processing comprises using heuristics to product at least one product solution **(Col. 2 Lines 48 – 52)**.

23. In regards to **claim 71**, **McCann** discloses further comprising presenting a plurality of product solutions to the customer **(Col. 3 Lines 1 – 22)**.

24. In regards to **claim 72**, **McCann** discloses wherein each product solution of the plurality of product solutions is qualified by a ranking selected from a plurality of rankings **(Col. 4 Lines 24 – 30)**.

25. In regards to **claim 73**, **McCann** discloses wherein the plurality of rankings comprise recommended, compatible, and not recommended **(Col. 3 Lines 18 – 22)**.

26. In regards to **claim 74**, **McCann** discloses further comprising providing a script to the live human agent, wherein the act of providing a script is performed by the expert system via the computer system **(Col. 3 Lines 30 – 46)**.

27. In regards to **claim 75**, **McCann** discloses wherein the provided script relates to the act of obtaining information from the customer **(Col. 3 Lines 30 – 46)**.

28. In regards to **claim 76**, **McCann** discloses wherein the script comprises one ore more questions for the live human agent to ask the customer **(Col. 3 Lines 30 – 46)**.

29. In regards to **claim 77**, **McCann** discloses wherein the customer has no direct interaction with the expert system **(Col. 3 Lines 1 – 7)**.

30. In regards to **claim 78**, **McCann** discloses wherein the needs of the customer comprise telecommunications needs **(Col. 3 Lines 1 – 22)**.

31. In regards to **claim 79**, **McCann** discloses wherein the at least three product solutions comprises a telecommunications network configuration solution **(Col. 3 Lines 30 – 46)**.

32. In regards to **claim 80**, **McCann** discloses wherein at least a portion of the needs of the customer are represented as data points **(Col. 3 Lines 39 – 46; Col. 6 Lines 37 – 47; Col. 11 Lines 24 – 42; Col. 12 Lines 34 – 38; Col. 15 Lines 42 – 45; Col. 35 – 36 Lines 65 – 4)**.

33. In regards to **claim 81**, **McCann** discloses wherein that at least a portion of the needs of the customer are represented as data points by the live human agents during the act of entering the information into the computer system **(Col. 3 Lines 39 – 46; Col.**

6 Lines 37 – 47; Col. 11 Lines 24 – 42; Col. 12 Lines 34 – 38; Col. 15 Lines 42 – 45; Col. 35 – 36 Lines 65 – 4).

34. In regards to **claim 82**, **McCann** discloses wherein the at least a portion of the needs of the customer are represented as data points by the expert system during the act of processing the information **(Col. 3 Lines 39 – 46; Col. 6 Lines 37 – 47; Col. 11 Lines 24 – 42; Col. 12 Lines 34 – 38; Col. 15 Lines 42 – 45; Col. 35 – 36 Lines 65 – 4)**.

(10) Response to Argument

Rejection under 35 U.S.C. 102(e)

Pages 14 – 15

35. Appellant argues that the rejection made under **35 U.S.C. 102(e)** towards **claims 1 – 8, 66, and 67** is improper for two reasons. The reasons being the following:

1. "First, the above referenced claims, due to their depending from claim 1, require an output comprising multiple alternative solutions to be generated by an expert system."

2. "Second, the above referenced claims also require that the multiple alternative solutions be selected by the expert system itself."

The appellant has provided a detailed explanation in an attempt to distinguish McCann from the above referenced claims, i.e. **claims 1 – 8, 66, and 67**.

Pages 15 – 17

36. Appellant argues that **McCann** fails to disclose or teach an output comprising multiple alternative solutions: a recommended solution, a compatible solution, and a not

recommended solution. As best understood by the Examiner, the appellant specifically argues that **McCann** fails to disclose more than one solution.

However, as discussed in the previous Office Actions, as well as during the over the phone interview on December 27, 2007, the Examiner asserts that **McCann** does, indeed, disclose multiple solutions, including a recommended solution, a compatible solution, and a not recommended solution. As discussed, **Fig. 51** of **McCann** discloses an "Incremental Editor" which comprises a recommended solution, compatible solution, and a not recommended solution.

As was explained to the appellant, the "Incremental Editor" provides a user with a recommended solution, in this case components for a computer system. **McCann** further discloses that within the "Incremental Editor" the user is provided with the choice to look through various other solutions that were not initially recommended, but compatible with the user's computer system, i.e. compatible solutions and not recommended solutions. In other words, **McCann** provides a user with a recommended solution, which is the initial solution presented to the user in the "Incremental Editor" interface. However, as discussed in the rejection above, the "Incremental Editor" also provides the user with other solutions that are within the guidelines of the user provided parameters. Consequently, the user is also presented with multiple solutions aside from the initially recommended solution. With that said, the Examiner asserts that the multiple solutions are, indeed, compatible solutions, since they solutions that are compatible with the user provided parameters, and not recommended solutions, since

they are solutions that were not initially presented to the user since they may not have been solutions that were the best solutions for the user.

Regarding the appellant's argument of providing a solution at random, the Examiner points out within the citation that was provided in the footnotes on pages 16 – 17 **McCann** points out that only when there are multiple recommended solutions that best meet the criteria of a user will a solution from that set of best solutions be selected at random. Not only does **McCann** anticipate the appellant's invention, but it also provides a solution for a scenario where multiple solutions are equivalent. As one of ordinary skill in the art of computers would know there are multiple components that can be substituted into a computer system and still attain a computer that can fully perform a user's requirements. For example, a customer who knows very little about computers and only requests the live agent to create a computer that can perform intensive graphic designs can be presented with several component configurations, all of which are equally capable of performing the needed tasks of the customer. **McCann** anticipated such an event and is the reason why a solution is selected at random. As a result, **McCann** does not avoid presenting multiple solutions to a user, but avoids presenting multiple recommended solutions to a user at once.

Therefore, it is asserted that **McCann** does, indeed, provide a user with multiple alternative solutions, including a recommended solution, compatible solution, and a not recommended solution.

Page 17

37. Appellant argues that the, "…arguments provided in support of the rejection of claim 1 are still flawed because they do not even address whether the "recommended solution," the "compatible solution" and the "not recommended solution" are disclosed in McCann in the same manner as they are arranged in the claim." Applicant provides arguments towards four specific arguments made by the Office Action regarding "compatible" and "not recommended" solutions, which begin at the bottom of **page 17**.

Point 1:

38. Appellant argues that the Examiner's rejection pertaining to the non-functional limitations is improper. The Examiner is unsure as to exactly why it is improper since the appellant has failed to properly discuss why presenting multiple solutions to a user without using or implementing those solutions are functional. As stated in the rejection above, the Examiner points out that the multiple solutions are never used or implemented by either the live agent or the customer. As a result, whether the provided solution is a recommended solution, compatible solution, or not recommended solution the type of solution is irrelevant since none of the solutions are ever implemented or considered. The Examiner asserts that all that has been done is take information from a user, input it into the system, process the inputted data, and present more data. Consequently, one of ordinary skill in the art would have realized that the appellant's claimed invention is no different than the invention as disclosed by **McCann** since **McCann** also discloses a system that processes inputted data in order to output the corresponding data. One of ordinary skill in the art would not have found it uniquely challenging or difficult to simply give the type of data a specific name, i.e.

recommended, compatible, and not recommended, so long as the presented data is based on the inputted data.

Point 2:

39. Appellant argues that **McCann** does not disclose that the expert system selects the compatible solution. However, as discussed above, the expert system does, indeed, select the compatible solution because only solutions that are compatible with the user's parameters are provided within the "Incremental Editor". In other words, **McCann** has provided a database that contains numerous components for computer systems. As can be understood, the components alone do not create a computer system, but provide the necessary information for the expert system to create a computer system that complies with a customer's parameters, i.e. at least a compatible solution. With that said, the expert system of **McCann** processes the user's parameters in order to provide solutions to the user that complies with the user's parameters. As a result, **McCann** does, indeed disclose solutions that are based on the user's parameters.

Moreover, it also appears that the appellant is attempting to argue that **McCann** fails to disclose that all of the solutions are presented simultaneously without specifically stating that the solutions must be presented simultaneously. However, as currently claimed in the instant application nowhere is it claimed that the solutions must be presented simultaneously to the user. Consequently, the Examiner asserts that one of ordinary skill in the art would have found it obvious that **McCann** does, indeed, disclose presenting solutions to the user. Although, the solutions may require the user to select

the "+/-" buttons to view the multiple solutions the solutions are, nevertheless, initially selected by the expert system and stored within the "Incremental Editor" interface. With that said, one of ordinary skill in the art would not have found it uniquely challenging or difficult that the provided solutions can be presented in various manners, all of which are a matter of design choice for the programmer. Such examples are, but not limited to, presenting the solutions simultaneously, presenting the solutions in different interfaces, or presenting the solutions in a single interface wherein the solutions are embedded within the single interface and require user interaction.

Point 3:

Appellant argues that **McCann** fails to disclose a "not recommended solution" being presented to the user. Regarding the not recommended solution, the Examiner asserts that **McCann** accomplishes this in two ways. The first being that any solution that was not initially presented to the user in **Fig. 51** is a "not recommended solution." That is to say, the compatible solutions are also considered to be "not recommended solutions" in that a compatible solution is not the recommended solution that the system initially provided to the user. Second, the user also has access to all available products that the system may provide. As a result, any solution that has not been presented to the user through **at least** the incremental editor is considered a "not recommended solution" and although the not recommended solution has not been displayed the user still can be presented with the not recommended solutions by just navigating through the expert system. Regarding how they are presented to the user the Examiner has already addressed the issue above.

Point 4:

40. Appellant argues the Examiner's rationale of an additional method provided to a user regarding how the information is presented to the user. As discussed above, the appellant is completely silent on the specifics of how the information is presented to the user. The Examiner's alternate interpretation of how the information can be presented to the user was only provided in order to convey to the appellant on the ambiguity of how the information is supposed to be presented to the user. Further, even though the print-modify-print-modify method may appear cumbersome to the appellant the Examiner asserts that this point of view is only dependant on what is available to a user and what the viewer regards as cumbersome. For example, the Examiner notes that printing and modifying is far simpler and much less cumbersome when compared to forcing a user to find a piece of paper, pencil/pen, and have the user write out the information. In the end, the information is still presented to the user.

Further, the Examiner is uncertain of what the appellant is arguing at the bottom of page 20 to the top of page 21. It appears to the Examiner that the appellant is, again, attempting to argue that the appellant information prints out all of the solution simultaneously are all on one sheet of paper. However, as discussed above, the Examiner asserts that no such claim has been made wherein the solutions are presented simultaneously.

Moreover, regarding appellant's argument stating that, "Since the Final Office Action was mailed in May of 2008, nearly seven years after the filing date of the subject application, the cited print-modify-print-modify-print-compare process is not prior art

relative to claim 1, and should not have been used to support the rejection of that claim," the Examiner is uncertain of what the appellant is attempting to argue. First, the Examiner asserts that no additional prior art was provided to provide this statement. Second, it appears to the Examiner that the appellant is arguing that they have provided the novel feature of printing multiple documents in order to allow a user to compare those documents. While the assertion made by the Examiner occurred after the time of the filing the Examiner finds it hard to believe that one of ordinary skill in the art at the time of the invention would have not found printing to be an obvious means for comparing information, since it is old and well known to have a printer attached to a computer for that exact purpose.

Claims 41 – 46

41. The Examiner asserts that appellant's arguments toward **claims 41 – 46** are similar in nature as those that have been discussed above. Consequently, the Examiner asserts that the arguments have already been responded to.

Claim 51

42. With the exception of the output having different ratings, the Examiner asserts that the appellant's arguments are similar in nature as those that have been discussed above. Consequently, the Examiner asserts that the arguments have already been responded to.

43. Regarding the output having different ratings, the Examiner asserts that the solutions provided by **McCann** are only accomplished because they are based on a rating system. That is to say, the expert system of **McCann** processes the user's

parameters and rates/ranks all of the components in order to properly determine the best (recommended) and alternate solutions that may not be the best (compatible and not recommended solutions) to the user **(see also at least Figures 9 and 10)**.

Claims 68 – 82

44. The Examiner asserts that appellant's arguments toward **claims 68 – 82** are similar in nature as those that have been discussed above. Consequently, the Examiner asserts that the arguments have already been responded to.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Gerardo Araque Jr.

/Gerardo Araque Jr./

Examiner, Art Unit 3689

Conferees:

Janice Mooneyham

/Janice A. Mooneyham/

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